

REMARKS

The Office Action of December 7, 2003 addresses the examination of claims 1-7. These claims remain pending and unamended.

Claims 1-7 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 7-12 of US 6,656,955, claims 7-10 of US 6,440,998 and claims 1-7 of US 6,451,851. These rejections are respectfully traversed. Reconsideration and withdrawal thereof are requested.

Claims 1-7 are further rejected under 35 USC § 103(a) as being unpatentable over Sumegi WO '675 or '676. These PCT publications are the International Applications from which the above-cited US patents issued.

The Examiner acknowledges that the cited references describe (§ 103 rejection) or claim (obviousness-type double patenting rejection) treatment of conditions other than actinic keratosis. The Examiner's position is that these references disclose the compounds described in the instant claims 1-7 and that when the administration may be topical, the instant invention is effectively practiced.

First, as to the obviousness-type double patenting rejections, the Examiner is reminded that it is only the claims of the reference, not its entire disclosure, that may be used as

the basis for rejection. The claims of all of the cited US patents describe pharmaceutical compositions. US '851 claims compositions for treatment of viral infection. US '998 claims compositions containing platinum-containing antitumor compounds for treatment of tumors. US '955 claims compositions containing taxol-type antitumor compounds for treatment of tumors. There is absolutely no teaching of topical application of an amidoxime compound according to the present invention in the claims of these references, nor any suggestion of this. Accordingly, the instant claims 1-7 cannot be considered obvious in view of the claims of the cited US patents, and the instant rejections should be withdrawn.

Furthermore, the Examiner relies upon an inherency theory to make his rejections. Inherency may be used as a basis for rejection of claims for lack of novelty, but it is improper to use this legal theory to ground a rejection for obviousness. Inherency requires that the result that is deemed inherent must be a necessary one, not merely a possible or even a likely result. That the Examiner finds that the presently-claimed invention is not anticipated by the references establishes as a matter of law that rejections of the claims for either obviousness-type double patenting or obviousness over the disclosure of the references is improper. Accordingly, all of the standing rejections must be withdrawn for this reason alone.

Still further, the Sumegi references are not in fact prior art to the instant claims. The Examiner has noted the priority claim of the present application to 1995. The Examiner indicates, however, that the present application is a Continuation-In-Part application and therefore has not accorded priority of the present claims back to that date.

The Examiner should note that the present application claims priority to U.S. Application No. 09/205,281, filed December 4, 1998. This is 26 days prior to the publication date of the cited Sumegi references.

The amidoxime compounds of the present invention and their use in treatment of actinic keratosis, especially as set forth in the present claims 3 and 7, are disclosed in the '281 application, as shown in column 3, line 51 and in column 5, line 56 of US 6,458,371, issued from the '281 application.

As the Sumegi PCT publications are not prior art to the present invention, the rejections under 35 USC § 103(a) of claims 1-7 over these references should be withdrawn.

The present application well-describes and claims patentable subject matter. The favorable action of allowance of the pending claims and passage of the application to issue is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. 36,623) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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